

- CERTIFICATE OF MAILING UNDER 37-C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: March 18, 2005 Name: Gregory H. Zavja - Reg. No. 48,059 Signature: Gregory Zavja

**BRINKS  
HOFER  
GILSON  
& LIONE**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Appln. of: **Robert K. Ellis II**

Patent No.: **6,843,177**

Issue Date: **January 18, 2005**

Serial No. **09/954,447**

Filing Date: **September 14, 2001**

For: **Methods and Materials for Producing an Image, and Articles Comprising Materials for Producing an Image**

Attorney Docket No: **3410/11**

Examiner: **Eugene H. Eickholt**

Art Unit: **2854**

Mail Stop Patent Ext.  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL**

Sir:

**Attached is/are:**

- ☒ Transmittal Letter (in duplicate); Request for Reconsideration of Patent Term Adjustment Pursuant to 37 CFR § 1.705(d) (in duplicate); Exhibits A-C
- ☒ Return Receipt Postcard

**Fee calculation:**

- ☒ No additional fee is required.
- ☒ Small Entity.
- ☐ An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_\_).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+	
								\$360=	
					Total	\$		Total	\$

**Fee payment:**

- ☐ A check in the amount of \$\_\_\_\_\_ is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16, and any patent application processing fees under 37 CFR § 1.17-1.18 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

March 18, 2005  
Date

Gregory Zayia  
Gregory H. Zayia (Reg No. 48,059)



(hereafter "PTA") of seventy-six (76) days. A copy of the Patent is included herewith as Exhibit A.

Applicant believes that the PTA should be one hundred and ninety six (196) days. For the reasons stated herein, reconsideration of the PTA is respectfully requested pursuant to 37 CFR 1.705(d). Because the error in computation of the PTA for the Patent appears to stem from the Office, Applicant respectfully requests that the petition fee under 37 CFR § 1.18(e) be waived. However, if any fees are deemed necessary for any reason relating to this communication, the Commissioner is hereby authorized to deduct the fees from Brinks Hofer Gilson & Lione Deposit Account No. 23-1925. A duplicate copy of this document is enclosed.

The PTA for the Patent was calculated by the U.S. Patent and Trademark Office based on activities and associated dates detailed in the Patent Application Information Retrieval (PAIR) system Patent Term Adjustment History, attached as Exhibit B. Applicant believes that errors and/or omissions in the calculation and/or the PAIR system Patent Term Adjustment History may have resulted in an incorrect PTA for the Patent as described in detail below. Pursuant to 37 CFR §1.705(d), this request for reconsideration is being filed within two months of the issue date of the Patent. Note that the Patent is not subject to a terminal disclaimer.

**Period of adjustment for activities prior to mailing of Notice of Allowance**

As detailed in the Patent Term Adjustment History (Exhibit B), the PTA at the time of mailing of the Notice of Allowance was forty-four (44) days. At the time the Notice of

Allowance was mailed, the PTA of forty-four (44) days corresponded to the sum of the periods calculated under paragraphs (a) through (e) of 37 CFR § 1.703, which was 151 days (but which has since increased to 303 days as explained below), minus the sum of the periods calculated under 37 CFR § 1.704, which was and still remains 107 days.

**Period of adjustment pursuant to 37 C.F.R. § 1.703(a)(6)**

The period of adjustment pursuant to 37 CFR § 1.703(a)(6) is the number of days in the period beginning on the day after the date that is four months after the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued. As shown in the Patent Term Adjustment History (Exhibit B), the issue fee was received in the Office on April 19, 2004 and the Patent issued on January 18, 2005, resulting in a period of adjustment under 37 CFR § 1.703(a)(6) of 152 days. Thus, the total delay for which the Office is currently responsible is 303 days, which corresponds to the sum of 151 days for the period of adjustment under 37 CFR § 1.703(a) plus 152 days for the period of adjustment under 37 CFR § 1.703(a)(6).

In accordance with 37 CFR § 1.704, the total period of time by which the 303 day adjustment of patent term should be reduced is only 107 days, the sum of a first reduction of 43 days and a second reduction of 64 days pursuant to 37 CFR § 1.704(b)—both of which reductions stem from activities prior to the mailing of the Notice of Allowance, as further explained in Exhibit C attached herewith and discussed below.


However, the Office has erroneously added an additional 120 days of Applicant delay under 37 CFR § 1.704(c)(10) for what is identified in the Patent Term Adjustment History (Exhibit B) as a "Miscellaneous Incoming Letter" received on April 19, 2004. Applicant notes that the document identified as a "Miscellaneous Incoming Letter" corresponds to Applicant's timely filed Application for Patent Term Adjustment Under 37 CFR § 1.705(b), attached herewith as Exhibit C. This Application, which was granted by the Office of Petitions on November 16, 2004, was necessary to correct a previous computational error by the Office in determining the patent term adjustment at the time of mailing the Notice of Allowance. Applicant does not believe that the filing of the Application for Patent Term Adjustment Under 37 CFR § 1.705(b) (Exhibit C) qualifies as a submission under 37 CFR § 1.704(c)(10) that may be used to reduce the period of patent term adjustment. Accordingly, Applicant respectfully requests that the reduction in patent term adjustment of 120 days attributed to Applicant's filing of an Application for Patent Term Adjustment Under 37 CFR § 1.705(b) be removed and that the patent term adjustment of the Patent be recalculated to take this into account.

**Total patent term adjustment**

The total patent term adjustment pursuant to 37 CFR § 1.703(f) is the period of adjustment pursuant to 37 CFR § 1.703 reduced by any delay pursuant to 37 CFR § 1.704. Thus, Applicant believes that the patent term adjustment should be 303 days – 107 days = **196 DAYS**, instead of the 76 days indicated on the Patent.

In summary, it is respectfully asserted that the PTA determined by the Office for U.S. patent number 6,843,177 B2 may not be correct. Accordingly, Applicant respectfully requests the Office to reconsider and make revisions to the PAIR system Patent Term Adjustment History in view of the remarks set forth above. In addition, it is respectfully requested that the PTA be re-calculated by the Office in view of the above remarks. Office personnel reviewing this application are invited to contact the undersigned agent directly at (312)-321-4257 if a discussion may help expedite reconsideration of the PTA.

Respectfully submitted,

  
\_\_\_\_\_  
Gregory H. Zayia  
Registration No. 48,059  
Agent for Applicant

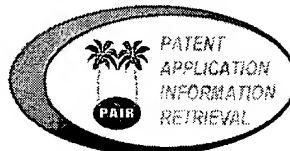
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(312) 321-4200



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## PATENT APPLICATION INFORMATION RETRIEVAL



## Patent Term Adjustment (PTA) for publication number: 09/954,447

			Days
Filing or 371(c) Date:	09-14-2001	USPTO Delay (PTO):	303
Issue Date of Patent:	01-18-2005	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	254
Post-Issue Petitions (days):	+0	Total PTA:	76
USPTO Adjustment (days):	+27	Explanation of Calculations	

## Search Options

Continuity Data
Image File Wrapper
File History
Maintenance Fees - Retrieve fees to pay
Maintenance Fees - View payment windows
Maintenance Statement - View 04 year payment window
Maintenance Statement - View 08 year payment window
Maintenance Statement - View 12 year payment window
Published Documents

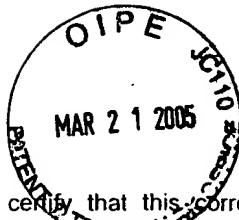
Maintenance Fees Available: Mon-Fri 5:30 AM to Midnight, Sat-Sun-Hol. 7:30 AM to 8:00 PM E.T.

## Patent Term Adjustment History

Date	Contents Description	PTO (days)	APPL (days)
12-29-2004	PTA 36 Months	↑	
01-18-2005	Patent Issue Date Used in PTA Calculation	152	
12-21-2004	Receipt into Pubs	↑	
12-20-2004	Dispatch to FDC	↑	
12-20-2004	Application Is Considered Ready for Issue	↑	
04-19-2004	Issue Fee Payment Verified	↑	
12-10-2004	Receipt into Pubs		
11-17-2004	IFW TSS Processing by Tech Center Complete		
04-19-2004	Miscellaneous Incoming Letter		120
11-16-2004	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance		↑
11-15-2004	Adjustment of PTA Calculation by PTO		↑
11-15-2004	Adjustment of PTA Calculation by PTO		↑
11-15-2004	Adjustment of PTA Calculation by PTO		↑
11-15-2004	Adjustment of PTA Calculation by PTO		↑
11-09-2004	Receipt into Pubs		↑
04-19-2004	Petition Entered		↑



04-19-2004	Workflow incoming petition IFW		↑
04-19-2004	Issue Fee Payment Received		↑
04-12-2004	Receipt into Pubs		↑
03-31-2004	Mail Examiner's Amendment		↑
03-30-2004	Examiner's Amendment Communication		↑
02-17-2004	Receipt into Pubs		↑
02-16-2004	Workflow - File Sent to Contractor		↑
01-20-2004	Mail Notice of Allowance		↑
01-14-2004	Issue Revision Completed		↑
01-14-2004	Notice of Allowance Data Verification Completed		↑
01-14-2004	Notice of Allowability		↑
01-07-2004	IFW Amended case processing Complete		↑
01-07-2004	Date Forwarded to Examiner		↑
12-04-2003	Response after Non-Final Action	64	
12-04-2003	Request for Extension of Time - Granted		↑
07-01-2003	Mail Non-Final Rejection		↑
06-19-2003	Non-Final Rejection		
06-04-2003	Date Forwarded to Examiner		
05-28-2003	Response to Election / Restriction Filed		
05-28-2003	Request for Extension of Time - Granted		
04-14-2003	Mail Restriction Requirement	151	
04-03-2003	Requirement for Restriction / Election	↑	
06-05-2002	Oath or Declaration Filed (Including Supplemental)	↑	
06-03-2002	Case Docketed to Examiner in GAU	↑	
09-14-2001	Information Disclosure Statement (IDS) Filed	↑	
03-27-2002	Application Dispatched from OIPE	↑	
03-26-2002	Application Is Now Complete	↑	70
02-27-2002	Payment of additional filing fee/Preexam	↑	↑
02-27-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	↑
10-15-2001	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	↑
10-12-2001	Correspondence Address Change	↑	
09-21-2001	IFW Scan & PACR Auto Security Review	↑	
09-14-2001	Initial Exam Team nn	↑	



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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
on April 15, 2004

Date of Deposit

Gregory H. Zayia – Reg. No. 48,059

Name of applicant, assignee or  
Registered Representative

*Gregory Zayia*

Signature

*April 15, 2004*

Date of Signature

Our Case No. 3410/11

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Robert K. Ellis, II

Serial No. 09/954,447

Filing Date: September 14, 2001

For: Methods and Materials for  
Producing an Image, and Articles  
Comprising Materials for Producing  
an Image

Examiner Eugene H. Eickholt

Group Art Unit No. 2854

### APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

A Notice of Allowance for the above-identified patent application was mailed on January 20, 2004, and contains a determination of a patent term adjustment (hereafter, "PTA") under 35 U.S.C. § 154(b) of seventeen (17) days, as of the determination date (Exhibit A).

Applicants believe that the PTA indicated in the Notice of Allowance is incorrect, and that the correct PTA is forty-four (44) days for reasons explained below.

## REMARKS

The fee for filing an application for PTA set forth in 37 CFR § 1.18(e) is enclosed. Please charge any additional fee required or credit for any excess fee paid to Deposit Account No. 23-1925. A duplicate copy of this Application is attached.

In support of this application, and in accordance with 37 CFR § 1.705(b)(2), the undersigned agent attests to the following statement of facts. The dates identified below were determined based on the mailing date stamped on communications sent by the Office and by the date of receipt stamped on the post card receipts returned by the Office.

(i) A Determination of Patent Term Adjustment under 35 U.S.C. 154(b) was mailed on January 20, 2004, which indicates a PTA of seventeen (17) days (Exhibit A) as of the determination date. However, Applicant believes that this PTA is incorrect, and that the correct PTA to date is forty-four (44) days. The basis for this adjustment is under 37 CFR 1.702(a)(1).

(ii) The period of adjustment under 37 CFR §1.703(a) is the number of days in the period beginning on the day after that date that is fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a) and ending on the date of mailing of an action under 35 U.S.C. § 132. The present application was filed on September 14, 2001. The date that is fourteen months after this filing date (hereafter, "the 14 month date") is November 14, 2002. The first Office Action under 35 U.S.C. § 132, a restriction requirement, was mailed on April 14, 2003. Thus, the difference between the 14 month date and the date of mailing of the first Office Action is 151 days, which accounts for all of the delay for which the Office is responsible to date.

(iii) The patent that will issue from the above-identified patent application is not subject to a terminal disclaimer.

(iv)(A) With respect to the grounds for adjustment set forth in 37 CFR § 1.704, an applicant is deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the

Office. Any such three-month period is measured from the date the notice or action was mailed to the applicant. The period of adjustment set forth in 37 C.F.R. § 1.703 shall be reduced by the number of days beginning on the day (hereafter, "the 3 month date") after the date that is three months after the date of mailing of the Office communication.

In the present application, a Notice to File Missing Parts was mailed on October 15, 2001. The 3-month date to respond to this communication was January 15, 2002. A Response to this communication was mailed, with a certificate of mailing, on February 13, 2002. The date-stamped return post card mailed back to Applicant indicates receipt by the Office on February 27, 2002 (Exhibit B). Accordingly, the first reduction in the period of adjustment of patent term under 37 CFR §1.704(b) is 43 days.

In addition, a non-final rejection against the present application was mailed on July 1, 2003. The 3-month date to respond to this Office Action was October 1, 2003. A Response to this non-final Office Action was mailed, with a certificate of mailing on December 1, 2003. The date-stamped return post card mailed back to Applicant indicates receipt by the Office on December 4, 2003 (Exhibit C). Accordingly, the second reduction in the period of adjustment of patent term under 37 CFR § 1704(b) is 64 days.

Thus, in accordance with 37 CFR § 1.704, the total period of time by which the period of adjustment of patent term should be reduced is 107 days (43 + 64).

#### Total patent term adjustment


In accordance with 37 CFR § 1.703(f), the total PTA to date for the above-identified patent application is the sum of the periods calculated under paragraphs (a) through (e) of 37 CFR § 1.703, currently 151 days, minus the sum of the periods calculated under 37 CFR § 1.704, which is 107 days. Thus, Applicant respectfully submits that the total PTA to date for the above-identified patent application is forty-four (44) days.

In view of the Remarks above, Applicant respectfully requests reconsideration of the PTA for the above-identified patent application. Office personnel reviewing this

application are invited to contact the undersigned agent directly at (312)-321-4257 if a discussion may help expedite reconsideration of the PTA.

Because the error in computation of the PTA for the above-identified patent application appears to stem from the USPTO, Applicant respectfully requests that the petition fee be waived.

Respectfully submitted,

  
\_\_\_\_\_  
Gregory M. Zayia  
Registration No. 48,059  
Agent for Applicant

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

## EXHIBIT A



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,447	09/14/2001	Robert K. Ellis II	3410/11	6569
7590	01/20/2004			
BRINKS HOFER GILSON & LIONE P.O. Box 10395 Chicago, IL 60610			EXAMINER EICKHOLT, EUGENE H	
			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 01/20/2004

## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)

(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 17 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 17 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.



## EXHIBIT B

Case No. 3410/11  
Applicant Robert K. Ellis II

Director of The United States Patent & Trademark Office  
Washington, D.C. 20231

Please acknowledge receipt of the below-identified:

Serial No: 09/954,447

Transmittal Letter (in duplicate), Notice to File Missing  
Nonprovisional Application Filing Date Granted, Response to Notice to  
File Missing Parts of Nonprovisional Application Filing Date Granted (in  
duplicate), Petition and Fee for Two (2) Month Extension of Time (in  
duplicate), Declaration, Power of Attorney, Checks for \$729 and \$200  
and Return Postcard.

BRINKS HOFER GILSON & LIONE

By: Gregory H. Zayia - Reg. No. 48,059

Date of Mailing: February 13, 2002



## EXHIBIT C

Serial No. 09/954,447  
Applicant: ROBERT K. ELLIS, II  
Client/Matter No.: 3410-11

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Please acknowledge receipt of the below identified:  
Items Mailed: Transmittal Letter (in duplicate), Response, Petition and Fee  
for Two (2) Month Extension of Time (in duplicate), Checks for \$210 and \$86,  
and Return Postcard.

BRINKS HOFER GILSON & LIONE  
By: Gregory H. Zayia, Reg. No. 48,059  
Date of Mailing: December 1, 2003

